



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/658,387

09/08/2000

Aureliano Tan JR.

05452.002002

3461

22511 7590 05/30/2008

OSHA LIANG L.L.P.
1221 MCKINNEY STREET
SUITE 2800
HOUSTON, TX 77010

EXAMINER

DADA, BEEMNET W

ART UNIT

PAPER NUMBER

2135

NOTIFICATION DATE

DELIVERY MODE

05/30/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@oshaliang.com
buta@oshaliang.com

Office Action Summary	Application No. 09/658,387	Applicant(s) TAN, AURELIANO	
	Examiner BEEHNET W. DADA	Art Unit 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 6, 8, 9, 34, 64, 69 and 72-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6, 8, 9, 34, 64, 69 and 72-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in reply to an amendment filed on April 02, 2008. Claims 1, 6, 8, 9, 34, 64, 69 and 72-75 are pending.

Response to Arguments

Applicant's arguments filed April 02, 2008 have been fully considered but they are not persuasive. Applicant argues that the art on record fails to teach a microprocessor identity that uniquely identify the microprocessor and further argues that Cooper (US 5,689,560) fails to disclose using the machine id to encrypt any digital identity data. Examiner disagrees.

Examiner would point out that, Cooper teaches unique attributes of a system (i.e., machine identifier) that is utilized for encryption of data, including system model number and hardware serial number [column 14, lines 21-30]. The machine id identifies components within the machine and since microprocessor is one of components within a system, microprocessor id is equivalent to machine id as taught by Cooper [column 14, lines 21-30]. Cooper further teaches Microprocessor identity that is encrypted (column 14 lines 51-53) by the digital identity data using an algorithm that uses a random number (column 14 lines 55-65) and an encryption of personal information (key file) using serial number (key; column 15 line 62 to column 16 line 9) and therefore teaches the limitation encrypting the digital data using the microprocessor identity.

Applicant argues that, Cooper and Ward cannot be properly combined. The teachings of Ward cannot be used to modify the teachings of Cooper as such modification would render the invention in Cooper unsatisfactory for its purpose, and it would not be feasible to subsequently etch the machine id into the microprocessor. Examiner disagrees.

Examiner would point out that, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, both references, Copper and Ward are directed to identification of components of a computer system. As disclosed by Ward, the teaching of etching an identifier to a computer component (column 3 lines 3-13) such as a microcontroller (column 1 lines 15-20) could have been modified into the device identifier that identifies a component in a computer system as taught by Cooper, because computer system is typically comprised of many component with some of which are more expensive than others and etching the serial number to the microprocessor combats the microprocessor from taken from the computer (Ward column 1 lines 25-32).

Examiner would point out that the art on record teaches the claim limitations and therefore, the rejection is respectfully maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 8-9, and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper (5,689,560) and in view of Ward et al (6,083,771).

In reference to claim 1, Cooper discloses a method and apparatus is provided for distributing software objects from a producer to a potential user (abstract). The system of Cooper includes a microprocessor (machine identification, column 14 lines 21-33), digital identity data, wherein the digital identity data uniquely identifies a user of the digital identity device (column 14 lines 21-22). Microprocessor identity that is encrypted (column 14 lines 51-53) by the digital identity data using an algorithm that uses a random number (column 14 lines 55-65). The system discloses the encryption of personal information (key file) using serial number (key; column 15 line 62 to column 16 line 9). Cooper further discloses a digital identity that comprises a name of the owner (column 13 lines 10-17), wherein the microprocessor identity is an alpha-numeric value (column 13 line 65 to column 14 line 5).

Although Cooper disclose the encryption of user data with a key derived from a machine id and microprocessor and the encryption of the user data, Cooper does not disclose etching the id on the microprocessor.

Ward discloses a method and system for manufacturing theft-deterrent computer components is disclosed. In the system of Ward the identifier (serial number) is etched to the computer component (column 3 lines 3-13) such as a microcontroller (column 1 lines 15-20). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to etch the identifier into the controller as performed by Ward in Cooper. One of ordinary skill in the art would have been motivated to do this because the computer is typically comprised of many component with some of which are more expensive than others and etching the serial number to the microprocessor combats the microprocessor being taken from the computer (Ward column 1 lines 25-32).

In reference to claim 8, wherein the digital identity device further comprises a computer interface configured to enable the digital identity device to communicate with an external device (Fig. 1).

In reference to claim 9, wherein the interface comprises an input/output port (Fig. 1).

In reference to claim 69 wherein the owner is a corporation, wherein the name is an incorporation name of the corporation, and wherein the digital identity data comprises at least one selected from the group consisting of a data and place of incorporation of the corporation, a name of a corporate officer of the corporation, and corporate partner of the corporation. Cooper teaches the customer key (Fig. 18). The customer key corresponds to a name because of the identifying function or qualities of the customer key, which is the function of a name.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper in view of Ward as applied to claims 1 and 34 above, and further in view of the article by Friedman ("The Trustworthy Digital Camera: Restoring Credibility To The Photographic Image").

In reference to claim 6, wherein the digital identity is for one of the group consisting of an individual and a corporation; and wherein the digital identity at least one selected from the group consisting of a digital picture, an address, a date of birth, a social security number, a driver's license number, a digital photograph, biometric information, credit card information, and a database administrator name.

Friedman discloses a digital identity in form of a digital photograph (image; page 908 column 2, the first full paragraph).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to etch the key into the controller as performed by Friedman in the system of Cooper. One of ordinary skill in the art would have been motivated to do this because credibility of the camera's output becomes an extension of that of the manufacturer; thus a digital signature from the camera can be considered to be just as reliable and secure as if the signature had been generated by the manufacturer (Friedman page 908 column 1, the first full paragraph).

Claims 34, 64, and 72-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper in view of Ward as in claim 1 and further in view of Guthery and Yap et al (6,111,506) and further in view of Paolini (6,847,948).

In reference to claims 34 and 73, is rejected as disclosed in claim 1 above. In reference to claim 73, Cooper teaches and two separate memories; (i) a digital identity device including two separate memories; (ii) digital identity data stored in the first memory; and (iii) an operating system in the second memory binding the digital identity data and the microprocessor identity (Fig. 1). The additional limitation of obtaining digital identity data from a digital device operatively connected to a computer in which the electronic document is stored is taught by Guthery. Guthery discloses a computer having a microprocessor containing identity information (column 5 lines 25-40 in combination with column 6 line 49 to column 7 line 5). The system includes obtaining digital identity data from a digital identity device operatively connected to a computer in which the electronic document is stored (Fig. 1). Guthery discloses a system that comprises a microprocessor (Fig. 2 part 52). Guthery further discloses a system that comprises digital identity data wherein the digital identity data is associated with a user of the digital identity

device; a memory configured to store at least the digital identity data (column 5 lines 7-15; column 6 lines 44-50; column 7 lines 13-21; Fig 2 part 58).

Guthery discloses a card ID (column 7 lines 1-5) which poses as the microprocessor identity due to the fact that the card ID belongs to the card; and therefore everything on the card and the card only has one microprocessor (Fig. 2). It follows that the ID identifies the contents of the card and therefore identifies the microprocessor. Even if the card ID is not a microprocessor identity, Paolini discloses a method and apparatus is disclosed for preventing an unauthorized computer system from using copied software or data (abstract). The system uses a CPU ID (microprocessor ID) of a particular computer system (column 3 lines 1-5). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use a microprocessor ID in the smart card of Paolini in the system of Guthery. One of ordinary skill in the art would have been motivated to do this because the ID is a unique quantity that can be used to prevent the use of copied software.

Although Guthery discloses storing information such as licenses and therefore documents (column 6 lines 45-50) and the system has passwords (column 6 lines 62-67) and a program for encryption (column 6 lines 25-30), Guthery does not disclose encrypting the documents. Yap discloses storing documents on the smart card. The documents are encrypted. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to encrypt the documents as in Yap with the digital identity data of Guthery and storing the documents on the smart card as in Guthery. One of ordinary skill in the art would have been motivated to do this because it would discourage forgery.

Guthery and Paolini do not disclose the etching of the microprocessor identity information into the microprocessor.

Ward discloses a method and system for manufacturing theft-deterrent computer components is disclosed. In the system of Ward the identifier (serial number) is etched to the computer component (column 3 lines 3-13) such as a microcontroller (column 1 lines 15-20). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to etch the identifier into the controller as performed by Ward in Cooper. One of ordinary skill in the art would have been motivated to do this because the computer is typically comprised of many component with some of which are more expensive than others and etching the serial number to the microprocessor combats the microprocessor being taken from the computer (Ward column 1 lines 25-32).

In reference to claim 72 wherein the owner is a corporation, wherein the name is an incorporation name of the corporation, and wherein the digital identity data comprises at least one selected from the group consisting of a data and place of incorporation of the corporation, a name of a corporate officer of the corporation, and corporate partner of the corporation. Cooper teaches the customer key (Fig. 18). The customer key corresponds to a name because of the identifying function or qualities of the customer key, which is the function of a name.

In reference to claims 64 and 74, wherein the digital identity is for one of the group consisting of an individual and a corporation; and wherein the digital identity at least one selected from the group consisting of a digital picture, an address, a date of birth, a social security number, a driver's license number, a digital photograph, biometric information, credit card information, and a database administrator name (bank information, column 7 lines 45-47; and column 6 lines 47).

Claim 75 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper in view of Ward and further in view of Guthery and further in view of Yap and further in view of Paolini as applied to claim 73 above, and further in view of the article by Friedman.

In reference to claim 75 wherein the owner is a corporation, wherein the name is an incorporation name of the corporation, and wherein the digital identity data further comprises at least one selected from the group consisting of an incorporation name of the corporation, a data and place of incorporation of the corporation, a name of a corporate officer of the corporation, and corporate partner of the corporation.

Friedman discloses a method securing a digital image (abstract). The image is secured using a unique key, therefore identification, which is etched to the camera's secure microcontroller (page 908 column 2, the first full paragraph).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to etch the key into the controller as performed by Friedman in the system of Cooper. One of ordinary skill in the art would have been motivated to do this because credibility of the camera's output becomes an extension of that of the manufacturer; thus a digital signature from the camera can be considered to be just as reliable and secure as if the signature had been generated by the manufacturer (Friedman page 908 column 1, the first full paragraph).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 2135

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BEEMNET W. DADA whose telephone number is (571)272-3847. The examiner can normally be reached on Monday - Friday (9:00 am - 5:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Beemnet W Dada/

May 22, 2008

/KIMYEN VU/

Supervisory Patent Examiner, Art Unit 2135